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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/872,415 | 06/02/2001 | Ilya Feygin | PH1092 | 2662 |
| 22897 | 7590 | 04/20/2004 | EXAMINER | |
| DEMONT & BREYER, LLC SUITE 250 100 COMMONS WAY HOLMDEL, NJ 07733 | | | SIEFKE, SAMUEL P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1743 | |

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 09/872,415 | Applicant(s) FEYGIN, ILYA | |
| | Examiner Samuel P Siefke | Art Unit 1743 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/28/04
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Arguments***

Applicant's arguments filed 1/28/04 have been fully considered but they are not persuasive. Applicant argues, "Joullie does not disclose (or even suggest) a detector that is capable of determining a plurality of locations on the specimen plate from which EM is emitted." The office would like to point to column 15, lines 8-11 and col. 18, lines 10-11 where Joullie discloses that the detector can be a human eye, a cameral, a photmultiplier tube or the like. Specifically a human eye is a detector that is capable of determining a plurality of locations (multiple finger prints) on a specimen plate from which the electromagnetic radiation is emitted corresponding to a plurality of target events (amine reaction with finger print) occurring at locations.

In response to applicant's argument that "Frankly it's not clear what the connection between Joullie and Sun is. The Office alleges that it would be obvious to modify Sun to include EM of Joullie to further test the surface of the deposit for surface imperfections" the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant argues, "there is no basis whatsoever for the Examiner to assert that "it would be obvious to put an atomizer and the detecto under a common

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housing. Most likely, this is physically impossible, unless the housing is the size of a room." A housing can be anything that encloses an object, example would be a room with an atomizer and a detector located within a room. The walls of the room would keep stray light out and reduce airflow around an object.

Therefore the limitation "a housing, wherein said atomizer is disposed in said housing" is taught by the prior art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8, 11, 12, 13, 16 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Joulli et al. (USPN 6,127,189).

Joulli discloses a method of detection of an amine compound in a fingerprint that comprises applying an atomized reagent (col. 14, lines 55-66) to a

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surface causing a reaction, then illuminating the surface by electromagnetic radiation (col. 4, lines 32-41) which emits radiation that is then detected by a detector (claim 1, 7,8). The optical property of the product comprises assessing the fluorescence of the product where the light emitting by this product is within the visual region of the electromagnetic spectrum. This occurs by illuminating the product with light of one wavelength and assessing emission at a second wavelength (col. 16, lines 14-27; col. 15, lines 34-55).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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Claims **8-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sun (USPN 6,482,264) in view of Joulli et al. (USPN 6,127,189).

Sun teaches a system and method for fabrication of coating libraries that comprises a movable substrate (electrical conductive having a plurality of predefined regions (col. 4, lines 43- col. 5, line11), a delivery mechanism (atomizer; col. 3, lines 28-65) along with a mask (col. 6, lines 7-56); a controller for monitoring and controlling all stations (col. 37-col.6, line 7); a testing device for testing the coating (col. 7, lines 18-30); a holding device for moving the substrate to each station (col. 4, lines 58-col.5, line11).

Sun does not teach any information regarding the use of electromagnetic radiation.

Joulli discloses a method of detection of an amine compound in a fingerprint that comprises applying an atomized reagent to a surface causing a reaction, then illuminating the surface by electromagnetic radiation which emits radiation that is then detected by a detector. It would have been obvious to modify Sun to include an electromagnetic radiation of Joulli in order to further test the surface of the deposit for surface imperfections. It would have been obvious to put an atomizer and the detector under a common housing in order to reduce the stray light coming from a nearby light source and atomized reagent from going into the surround air.

Conclusion

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel P Siefke whose telephone number is 571-272-1262. The examiner can normally be reached on M-F 7:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sam P. Siefke



April 19, 2004


Jill Warden
Supervisory Patent Examiner
Technology Center 1700